

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK DORI

Appeal No. 96-2779
Application 08/151,944¹

HEARD: JUNE 9, 1998

Before STAAB, McQUADE and CRAWFORD, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision in an appeal from the final rejection of claims 1 and 3-15, all the claims remaining in the application.

¹ Application for patent filed November 15, 1993.

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Appellant's invention pertains to a method of and an apparatus for displaying information along an extended area of compliant ground. By way of example, appellant's method and apparatus may be used to display a series of repetitive advertising or public service messages in a sandy bathing beach or a snow-covered ski area. Independent claims 1, 3, 9 and 14, copies of which are appended to appellant's brief, are representative of the appealed subject matter.

The references of record relied upon by the examiner in support of the rejections are:

Moorhead	3,832,079	Aug. 27, 1974
Brown	4,958,446	Sept. 25, 1990
Giliberti	5,088,855	Feb. 18, 1992

A new reference relied upon by this merits panel of the Board in support of a new rejection is:

Bruess	D51,917	Apr. 2, 1918
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Claims 1, 3, 4 and 7-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brown in view of Moorhead.

Claims 5, 6 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brown in view of Moorhead and further in view of Giliberti.

The rejections are explained in the examiner's answer

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(Paper No. 11).

The opposing viewpoints of appellant are set forth in the brief (Paper No. 10) and the reply brief (Paper No. 12).

*The § 103 Rejection of Claims 1, 3, 4 and 7-14
Based on Brown and Moorhead*

Brown pertains to "[a] disposable sandal . . . adapted to apply an advertising message repeatedly into sandy soil at a beach or the like" (abstract). As illustrated in Figure 1, "[t]he lower exposed surface 16 of the sole 12 is integrally molded with projections 18 defining a mirror image advertising message" (column 2, lines 25-28). As the individual wearing such a sandal walks along a beach, the message is stamped repeatedly along the sand. See Figure 2.

Moorhead relates to an apparatus and process for forming a pattern in the surface of wet, compliant concrete. As explained in column 1 of Moorhead in the background section of the specification, it is sometimes desirable for aesthetic purposes to provide a pattern in the surface of concrete to simulate hand laid bricks, stones, cobblestone, etc. According to Moorhead, this effect had been effectuated by

means of hand tools to strike the pattern in the concrete
(column 1, lines 24-26). In this regard, Moorhead states:

Hand stamping tools have been increased in size to effectuate coverage of broad areas. However, the process is relatively time consuming because of the fact that a man can only impress a limited amount of concrete as to the square footage that is being impressed. This [Moorhead's] invention overcomes the limitations of hand stamping concrete by providing a continuously rolling impressment.
[column 1, lines 55-62]

Specifically, Moorhead provides a tractor-like apparatus which includes a roller 16 having a surface 17 comprising ribs or blades 18 arranged in the pattern to be impressed into the concrete for continuously rolling impressment of the pattern.

The test for obviousness is not whether the features of one reference may be bodily incorporated into the structure of another reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, a conclusion of obviousness may be based on common knowledge and common sense of the person of

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ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Applying these principles to the presently appealed claims, the examiner's conclusion that the combined teachings of Brown and Moorhead would have suggested the subject matter recited in claim 1 is well founded. A person of ordinary skill in the art would have readily appreciated as a matter of common sense that Brown's method is limited in terms of the area over which the message can be impressed in a reasonable amount of time. Further, the ordinarily skilled artisan would have readily appreciated that Moorhead's teachings of providing a roller means to facilitate impressing a pattern in wet concrete is not limited to stamping concrete but has a broader applicability to other processes where impressing a repetitive pattern is done manually. These considerations would have provided the artisan with ample suggestion to provide an impressing means in Brown whereby the messages are impressed into the sand by rolling contact between the impressing means and the compliant ground to enhance the

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overall efficiency of the process. The resulting method would meet all of the limitations of independent claim 1.

Considering next independent apparatus claim 9, the step of providing an impressing means in Brown in view of Moorhead's teachings whereby the messages are impressed into the sand by rolling contact also results in the apparatus of claim 9. Accordingly, we will sustain the standing § 103 rejection of claim 9 based on the combined teachings of Brown and Moorhead.

We will also sustain the standing § 103 rejection of claims 10-13 since appellant states on page 5 of the brief that these dependent claims stand or fall with claim 9.

Turning to independent claim 3, this claim does not require that the messages be impressed by rolling. Rather, claim 3 calls for the steps of smoothing the compliant ground to establish a path of smoothed compliant ground, and impressing the messages into the compliant ground at regularly spaced intervals along the path of smoothed compliant ground. Appellant argues that in Brown the messages are not impressed in the sand at regularly spaced intervals. This argument is not well taken. In our opinion, the method of using Brown's sandals would inherently result in messages being impressed in the sand at regularly spaced intervals, since the length of a person's stride is consistent from stride to stride during normal walking. We appreciate that our views in this respect differ from those of appellant as expressed on page 1 of the reply brief.

Appellant also argues that the applied references do not teach smoothing the ground to establish a smooth path prior to impressing the message. However, appellant's specification

states on page 3 that during the peak tourist season, it is conventional for a grounds keeper to comb the beach each morning with a rake to maintain the beach clean and orderly for the day's use. Accordingly, it would have been obvious to utilize Brown's sandals to impress messages into the sand of a beach that has been earlier raked smooth, the resulting method corresponding to that of independent claim 3 in all respects.

We will not sustain the § 103 rejection of claims 4, 7 and 8, each of which depends from claim 3 and adds that the messages are impressed by rolling the impressing means along the smoothed compliant ground "immediately subsequent to smoothing" the compliant ground. In rejecting these claims, the examiner has taken the position that "[i]t is inherent of the Moorhead apparatus to impress a pattern 'immediately' subsequent to the smoothing means/process" (answer, page 6). This position is not well taken. We appreciate that in Moorhead, the concrete is tamped, floated and troweled in preparation for impressing the pattern in the concrete (column 2, lines 39-43). We also appreciate that tamping, floating and troweling concrete constitutes smoothing the surface thereof. It is not apparent to us, however, that Moorhead's

pattern impressing step inherently takes place "immediately subsequent" to smoothing the concrete surface. Rather, Moorhead's disclosure at column 4, lines 52-54 (the concrete is floated and troweled and then maintained in this state until impressed) and column 2, line 54 (the concrete is in a semi-plastic state prior to being impressed) suggest that a period of time elapses between the smoothing and impressing steps.

We also will not sustain the standing § 103 rejection of independent apparatus claim 14 as being unpatentable over Brown in view of Moorhead. Claim 14 requires that the apparatus thereof includes "means for smoothing the compliant ground . . . along the extended area immediately ahead of the impressing means." As noted in the previous paragraph, it is not inherent in Moorhead that smoothing the concrete take place immediately subsequent to impressing the pattern therein. Likewise, Moorhead does not teach, suggest or infer that the pattern forming apparatus should include as a part thereof a means for smoothing the concrete in the area immediately ahead of the roller 16. The examiner has not explained, and it is not apparent to us, why in combining the

teachings of Brown and Moorhead to effectuate impressing the message of Brown by rolling means, the resulting apparatus would also include the "means for smoothing" as called for in the last paragraph of claim 14. Accordingly, the rejection of claim 14 based on Brown and Moorhead is not sustainable.

*The § 103 Rejection of Claims 5, 6 and 15
Based on Brown, Moorhead and Giliberti*

Giliberti pertains to a small tractor for compacting surfaces. To this end, the tractor is equipped with a compacting cylinder 20. The cylinder is mounted for movement between an operative position wherein it engages the ground (e.g., Figure 5) and an inoperative position wherein it is spaced from the ground (e.g., Figure 7). In addition, Giliberti can be fitted with a brush 86 for raking a sand trap of a golf course (see Figure 1).

Claim 5 depends from method claim 3 and further requires that the smoothing step includes raking. In that appellant discloses on page 3 of the specification that it is conventional for a grounds keeper to comb the beach each morning *with a rake* to maintain the beach clean and orderly

for the day's use, utilizing Brown's sandals to impress messages into the sand of a beach that has been earlier raked smooth would result in the method of claim 5. Thus, we will sustain the rejection of claim 5, the teachings of Giliberti being mere surplusage to the rejection.

Claim 6 depends from claim 5 and further requires that the step of impressing by rolling take place "immediately subsequent to raking." As noted above in our discussion of claims 4, 7 and 8, the combined teachings of Brown and Moorhead do not teach, suggest or infer the step of smoothing compliant ground immediately subsequent to impressing a pattern therein. Giliberti does not make up for the deficiencies of Brown and Moorhead in this regard. It follows that the rejection of claim 6 based on Brown, Moorhead and Giliberti is not sustainable.

Claim 15 depends from claim 14 and adds that the "means for smoothing" includes a rake. While we appreciate that Giliberti's brush 86 for raking sand responds to the rake requirement of dependent claim 15, Giliberti's teachings do not make up for the above noted deficiencies of Brown and Moorhead with respect to basic combination needed to meet the

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terms of independent claim 14. Accordingly, the rejection of claim 15 is not sustainable.

New Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new rejection.

Claims 1, 3, 5 and 9-13 are rejected under 35 U.S.C. § 103 as being unpatentable over the newly cited Bruess reference.

Bruess discloses a tire having a thread pattern comprising a series of symbols each in the form of a stylized message "Ohio." It would have been obvious to one of ordinary skill in the art to provide the tire of Bruess on an automobile. The resulting combination would correspond to the apparatus of claim 9. In this regard, Bruess's tire having a tread pattern in the form of raised symbols representing the stylized message "Ohio" comprises means for temporarily displaying including rolling impressing means, as called for in the first two paragraphs of the body of claim 9. The automobile on which such a tire is mounted comprises means for rolling the rolling impressing means along the compliant

ground, as called for in the last paragraph of claim 9.

The apparatus called for in dependent claims 10, 11 and 13 would also result from providing the tire of Bruess on an automobile. The subject matter of claim 12, wherein the graphic elements are recessed within the outer surface, is considered to be an obvious alternative to that which is disclosed in Bruess, wherein the graphic elements are raised upon the outer surface of the tire.

As to method claim 1, it would further have been obvious to drive an automobile equipped with a tire like that of Bruess on soft compliant ground. The resulting method correspond to the method of claim 1 in all respects, in our view.

Concerning method claim 3, in light of appellant's disclosure on page 3 of the specification that it is conventional to comb a beach with a rake in preparation for the day's use, it would also have been obvious to drive a vehicle equipped with a tire like that of Bruess on a freshly combed sandy beach. The resulting method would correspond to the method of claims 3 and 5.

Summary

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The § 103 rejection of 1, 3, 4 and 7-14 as being unpatentable over Brown in view of Moorhead is affirmed with respect to claims 1, 3 and 9-13, but is reversed with respect to claims 4, 7, 8 and 14.

The § 103 of claims 5, 6 and 15 as being unpatentable over Brown in view of Moorhead and Giliberti is affirmed with respect to claim 5, but is reversed with respect to claims 6 and 15.

In addition, we have made a new rejection of claims 1, 3, 5 and 9-13 pursuant to 37 CFR § 1.196(b).

The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

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37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion

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of the prosecution before

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the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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JOHN P. McQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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